<u>REMARKS</u>

Claims 1-15 are pending in the Application.

Claims 1-15 stand rejected.

The Disclosure is objected to for informalities.

The Drawings are objected to for informalities.

Claims 2, 4, 7, 9, 12 and 14 are currently amended.

Applicants respectfully assert that all remaining claims are allowable and applicants respectfully request the Examiner to withdraw all outstanding rejections.

OBJECTIONS TO DISCLOSURE AND DRAWINGS

The Examiner objects to the Specification because item 356 appears in the text but item 356 is not correctly marked in the Figures. Office Action, 03/30/2004, paragraph 2. The reference to item 356 in the Specification was a typographical error. Applicants have amended the Specification text to correspond to Figure 3b. No new matter was added with the correction because Applicants changed the Specification only to correct an obvious typographical error. This change was made only to bring the Specification and Figure 3b into agreement and this correction does not add new matter or otherwise affect claim scope.

Applicant acknowledges Examiner's comments regarding the use of the IBM trademark. Office Action, 03/30/2004, paragraph 3. Applicants have reviewed the Specification's references to the IBM trademark. No changes to the Specification are required because the Specification uses "IBM" to describe the source and title of a document where a reader may find additional information regarding the technology in the Specification, and not in a trademark sense.

Figures 1-2 and 3a are objected for not having a legend containing the text "Prior Art." In response, Applicants have amended Figures 1-2 and 3a with "Prior Art" legends. Applicants have added these legends to Figures 1-2 and 3a without adding new matter to the Specification or drawings.

REJECTIONS UNDER 35 U.S.C. § 112, paragraph 2

Claims 1-15 stand rejected under 35 U.S.C. § 112, ¶ 2 for failing to particularly point out and distinctly claim the subject matter. Specifically, the Examiner cites a lack of antecedent basis for the term "said request" in claims 4, 9 and 14. Office Action, 03/30/2004, ¶ 5. In response, Applicant currently amends claims 4, 9 and 14 to recite "said access request" rather than "said request." As originally filed, there was an antecedent basis for "said request" despite the Examiner's rejections. "Said access request" is clearer than "said request," but both terms refer to the same subject matter. The addition of "access" was made for readability purposes rather than a substantial reason related to patentability. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 USPQ2d 1705 (U.S. 2002). Therefore, it is not a narrowing amendment and all relevant claims should have the same claim scope regarding this element despite this amendment. *Festo*, 62 USPQ2d 1705.

The Examiner rejects claims 2, 7 and 12 as unclear regarding the term "a directory." Office Action, ¶ 5(i). In response, Applicants currently amend claims 2, 7 and 12 to change the term "a directory" to "the directory" to more clearly define the claimed subject matter. As a result of the foregoing amendments, Applicants respectfully request that the Examiner withdraw all rejections based on 35 U.S.C. § 112, ¶ 2.

REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 1-15 stand rejected as obvious over *Elliott* (U.S. Patent No. 5,867,495) in view of *Asano* (U.S. Patent No. 6,477,577).

The basic test for nonobvious subject matter is whether the differences between the subject matter and the prior art are such that the claimed subject matter as a whole would not have been obvious to a person having ordinary skill in the art to which the subject matter pertains. The United States Supreme Court in *Graham v. John Deere & Co.*, 383 U.S. 1 (1966) set forth the factual inquiries which must be considered in applying the statutory test: (1) a determination of the scope and contents of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; and (3) resolving the level of ordinary skill in the pertinent art.

Determining Scope and Content of Prior Art

In determining the scope and content of the prior art, the Examiner must first consider the nature of the problem on which the inventor was working. Once this has been established, the Examiner must select, for purposes of comparing and contrasting with the claims at issue, prior art references which are reasonably pertinent to that problem (the inventor's field of endeavor). *See Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.,* 30 U.S.P.Q.2d 1377, 1379 (Fed. Cir. 1994). In selecting references, hindsight must be avoided at all costs.

The present invention relates to methods of providing a gateway of an IP network by interrogating a directory for data, retrieving parameters associated with the data, accessing an application server in accordance with retrieved parameters, and relaying data between the client application and application server. The parameters are retrieved in response to an access request from a client application of a first end-user. The Specification lists advantages of not requiring client applications to be gateway-aware for accessing external resources located beyond a gateway of an IP network. Specification, page 8, lines 6-8.

Elliott relates to a system and method for connecting telephone devices over networks. Col. 218, lines 29-34. Telephone calls, data, and other multi-media information are routed through a hybrid network. Information is transferred across the Internet utilizing telephone routing information and the Internet protocol address information. Col. 1, lines 25-30.

Asano relates to a connection substitute server which substitutes a connection between a host machine having an informal address and a host machine having a formal address. *Asano* Abstract. The connection substitute server can be an "application gateway server." Col. 1, lines 39-42. The application gateway server "substitutes the connection between a host machine having an informal address that is not formally allocated or a local address that is used in the organization and does not flow path information to the outside and a host machine which has the formal address and which is out of the organization and the server relays." Col. 2, lines 57-63.

Differences Between Prior Art and Claims

The second step within the test described in *Graham* is to ascertain the differences between the cited prior art and the claims at issue. A *prima facie* showing of obviousness requires the Examiner to establish that the prior art references teach or suggest, either alone or in combination, all of the limitations of the claimed invention. The showings must be clear and particular. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

Elliott is a very long reference and differs from the claimed subject matter in many ways. Generally, *Elliott* discloses telephone communications occurring over an Internet connection. The present application's Specification discusses using proxy servers to cache web documents and serve clients from a cache if possible to reduce Internet traffic. Such a proxy server would be of little use to *Elliott's* disclosed system or any other telephone system. Telephone conversations are not cacheable like other Web documents, therefore the proxy server disclosed in the Specification and claimed would be of no use for implementing an Internet telephone system such as *Elliott's*. Live conversations cannot be cached.

In addition to the differences between the prior references and the claims, not all limitations of the claims are found in the cited references. In rejecting independent claim 1, the Examiner cites to three unrelated sections of text in *Elliott*. Office Action, 03/30/2004, paragraph 8. For the first step of claim 1, "interrogating a directory comprising data for each end-user of said IP network," the Examiner cites to a section of *Elliott* which discloses an Automated Call Distributor. Col. 201, lines 24-25. In the Automated Call Distributor from *Elliott*, a dial-up Internet user uses a computer modem to dial a telephone number. Col. 201, lines 27-28. A switch completes the call to an Internet Access Device. Col. 201, lines 36-37. The dial-up Internet user starts a web browser, browses a Corporate Web Server, and opens a web page with an icon with text indicating that the user can talk to an agent by clicking on the icon. Col. 202, lines 35-36, 46-48. The user clicks on the icon and the user's web browser downloads a MIME file from the Corporate Web Server. Col. 202, lines 48-50. The browser invokes a helper, the helper reads the MIME file, and the helper engages a Directory Server to get an IP address using information from the MIME file information. Col. 202,

lines 52-61. The helper then launches an Internet telephone call through an Internet telephony gateway. Col. 202, lines 64-66.

For the "interrogating a directory" element, the Examiner cites to the Automated Call Distributor function in which the directory server uses MIME file information to translate an alphanumeric string into an IP address. Office Action, 03/30/2004 (citing Col. 202, lines 56-63). The cited section does not clearly disclose interrogation of "a directory comprising data for each end-user." A translation of an alphanumeric string to an IP address may occur without accessing a directory comprising data for an end user. Therefore, the Examiner has not shown that *Elliott* discloses the first step of claim 1. Nor does *Asano* or a combination of *Elliott* and *Asano* disclose the first step of claim 1.

Likewise, the Examiner has not established a *prima facie* case that *Elliott* discloses the second step of claim 1. The second step of claim 1 recites "retrieving parameters associated with said data." For this second step of claim 1, the Examiner cites an unrelated section of *Elliott* as compared to the first section of *Elliott* cited for the first step of claim 1. Office Action, 03/30/2004, paragraph 8. The second cited section of *Elliott* discloses retrieving network topology and configuration data, creating standardized topology data records, and storing the data for use by Network Management Systems (SNMS). Col. 116, lines 64-67. Applicants have not found, and the Examiner has not provided, any indication that this topology data has any relationship to the IP address translation conducted by the Directory Server discussed above with regard to the first step of claim 1. There must be a correlation under the claims because the second step of claim 1 clearly references the first step of claim 1 by using "associated with said data for each end-user." Therefore, by using "said data" the second step of claim 1 clearly references data from the first step of claim 1. There appears to be no such connection between *Elliott's* topology information and any data element disclosed with regard to an Automated Call Distributor. Further, the cited section of *Elliott* does not disclose that any parameters are retrieved "in response to an access request" as required by claim 1's second step. To the contrary, *Elliott* discloses that "the collection of data "occurs on a periodic basis." Col. 117, lines 12-15. A "periodic basis" is not in "response to an access request." For at least these reasons, the second step of claim 1 is not

disclosed by *Elliott*. Nor does *Asano* or a combination of *Elliott* and *Asano* disclose the second step of claim 1.

For the third step of claim 1, the Examiner cites to *Asano*. Office Action, 03/30/2004, paragraph 10. The third element of claim 1 cannot be disclosed by *Asano* because the third element of claim 1 refers to "on behalf of said client application" and *Asano* does not disclose the necessary client application from claim 1, step 2.

Likewise, the Examiner has not established a *prima facie* case *Elliott* discloses the fourth step of claim 1. For the fourth step of claim 1, the Examiner cites another unrelated section of *Elliott*. Office Action, 03/30/2003, paragraph 9 (citing to Col. 104, lines 20-31). The cited text discloses a client computer 1080 querying a directory server 1082 to determine the best choice of Internet Telephony Gateway. Col. 104, lines 24. In a prior step, Internet Telephony Gateways are ranked by order of average latency. Col. 103, lines 1-3, 58-60. In summary, the cited text discloses a client accessing a directory to find a fast gateway that will have low latency. The fourth step of claim 1 recites the element "said client application" and "said application server" which have antecedent basis in the second and third steps of claim 1. The Examiner has not established that *Elliott's* "client application" for finding a fast Internet Telephony Gateway is the same "client application" disclosed in *Asano*. Similarly, the Examiner has not established that it is the same as any "client application" from the cited section related to the second step of claim 1.

Claims 6 and 11 stand reject "for the same reason as the rejection to claim 1." Office Action, 03/30/2004, paragraph 15. As established in the foregoing, the Examiner has not established a *prima facie* case that *Elliott* and *Asano*, taken alone or in combination, disclose every limitation of independent claim 1. The foregoing arguments apply to independent claims 6 and 11, therefore, independent claim 1, 6, and 11 are allowable over *Elliott* in view of *Asano*.

The Examiner has not established a *prima facie* case that claim 2 is obvious over *Elliott* and *Asano*. To reject claim 2, the Examiner cites a section of *Elliott* that discloses a user's ability to access his or her account information through an application profile. Office Action, 03/30/2004, paragraph 12 (citing Col. 65, lines 55-65). The account information

resides on a user account directory and users may read and write to the directory to update their accounts. Col. 65, lines 59-63. Examiner does not cite to, and Applicants have not found, any indication that *Elliott's* disclosed directory includes entries "for every end-user on said IP network" as claimed. To the contrary, *Elliott* discloses that "the user account directory is limited to: directline MCI profile, Information Services profile, Global Message Handling, List Management and Personal Home Page profiles." Col. 66, lines 5-9. Therefore, *Elliott* explicitly teaches away from claim 2's subject matter creating a directory "including entries for every end-user on said IP network." Therefore, *Elliott* and *Asano*, taken alone or in combination, do not recite the limitations of claim 2.

Claims 7 and 12 stand rejected "for the same reason as the rejection to claim 2." Office Action, 03/30/2004, paragraph 16. As established in the foregoing, the Examiner has not established a *prima facie* case that *Elliott* and *Asano*, taken alone or in combination, disclose every limitation of independent claims 1, 6 or 11. The foregoing arguments for claim 2 apply to 7 and 12, therefore, dependent claims 7 and 12 are also allowable over *Elliott* in view of *Asano*. In summary, dependent claims 2, 7 and 12 are allowable over the references because the references do not disclose every element of independent claims 1, 6, 11 or dependent claims 2, 7, and 12. Further, the Examiner has not established a *prima facie* case that any claim is obvious over the references.

The Examiner has not established a *prima facie* case that claim 3 is obvious over *Elliott* and *Asano*. To reject claim 3, the Examiner cites to a section of *Elliott* discussing the ability to enable or disable predefined directline MCI profiles through a command submitted by a two-way pager. Office Action, 03/30/2004, paragraph 13 (citing to Col. 70, lines 45-47). The cited text does not disclose disabling entries of "end-users that disconnect" or enabling entries for "end-users that connect." Rather, the cited text discloses enabling or disabling profiles through a pager command. Col. 70, lines 45-48. Therefore, *Elliott* and *Asano*, taken alone or in combination, do not disclose these limitations.

The final step of claim 3 recites "updating said entries of said end-users comprising dynamic parameters." There is clearly an antecedent basis required for "entries" and "end-users." Despite this need for antecedent basis, the Examiner cites to an unrelated portion of

Elliott which discloses that "Ops consoles support the display of dynamic status through icon—based maps of various systems" "within the Data management domain." This cited section of *Elliott* has little relevance to any directline MCI profile that is enabled or disabled. The cited text from *Elliott* merely uses the word "dynamic," which is an insufficient reason to reject claim 3. *Elliott* does not disclose every element of claim 3. The Examiner has not established a *prima facie* case that *Elliott* discloses every limitation of independent claim 1 or dependent 3. Nor does *Asano* or a combination of *Elliott* and *Asano* disclose the first step of claim 3. Therefore, claim 3 is allowable over *Elliott*.

Claims 8 and 13 stand rejected "for the same reason as the rejection to claim 3." Office Action, 03/30/2004, paragraph 17. As established in the foregoing, the Examiner has not established a *prima facie* case that *Elliott* and *Asano*, taken alone or in combination, disclose every limitation of independent claims 1, 6 or 11. The foregoing arguments for claim 3 also apply to 8 and 13, therefore, dependent claims 8 and 13 are also allowable over *Elliott* in view of *Asano*. In summary, dependent claims 3, 8 and 13 are allowable over the references because the references do not disclose every element of independent claims 1, 6, and 11 and dependent claims 3, 8 and 13 .

The Examiner has not established a *prima facie* case that claim 4 is obvious over *Elliott* and *Asano*. The Examiner cites to at least 5 substantially unrelated sections of *Elliott* as rendering claim 4 obvious. Office Action, 03/30/2004, paragraph 19. For the "obtaining leading data" and "parsing said leading data" elements, Examiner cites to a subscriber's ability to retrieve, for faxmail and email messages, message headers containing priority, sender, subject, date/time, and size. Col. 68, lines 2-3. However, this first element of claim 4 recites that leading data is "from said client application having issued said access request." The antecedent basis for "said client application" and "said access request" is in claim 1. To establish these elements from claim 1, Examiner cited to a section of *Elliott* for retrieving network topology and configuration data. Col. 116, lines 65-67. The email or faxmail containing the leading data is substantially unrelated to the process of receiving network topology, and Applicants have found nothing to indicate the email or faxmail received by a subscriber corresponds to "obtaining leading data from said client application." *Elliott* does not disclose every element of independent claim 1 or dependent 4. The Examiner has not

established a *prima facie* case that *Elliott* and *Asano* discloses every limitation of claim 4. Therefore, claim 4 is allowable.

Claims 9 and 14 stand rejected "for the same reason as the rejection to claim 4." Office Action, 03/30/2004, paragraphs 21, 22. As established in the foregoing, the Examiner has not established a *prima facie* case that *Elliott* and *Asano*, taken alone or in combination, disclose every limitation of independent claims 1, 6 or 11. The foregoing arguments for claim 4 also apply to 9 and 14, therefore, dependent claims 9 and 14 are also allowable over *Elliott* in view of *Asano*. In summary, dependent claims 4, 9 and 14 are allowable over the references because the references do not disclose every element of independent claims 1, 6, and 11 and dependent claims 4, 9 and 14 .

The Examiner has not established a *prima facie* case that claim 5 is obvious over *Elliott* and *Asano*, taken alone or in combination. Claim 5 recites all of the limitations of independent claim 1 with the added limitation "informing said end-user of said client application that a server application is unavailable if a link to said application server is not established" (emphasis added). The Examiner cites to a portion of *Elliott* describing a list of Local Exchange Carrier (LEC) end office nodes. Office Action, 03/30/2004, paragraph 14 (citing Col. 120, lines 56-61). The only similarity between the cited passage and claim 5 is that both use the word "unavailable." The cited passage discloses than an "information list" may be valuable for determining which end offices are unavailable if a specified LEC tandem switch is isolated. Col. 120, lines 59-60. The cited passage appears to have no relevance to the antecedent basis for any "said end-user," "said client-application," or "said application server." *Elliott* and *Asano*, taken alone or in combination, do not disclose every element of independent claim 1 or dependent 5. The Examiner has not established a *prima facie* case that *Elliott* and *Asano*, taken alone or in combination, disclose every limitation of claim 5. Therefore, claim 5 is allowable.

Claims 10 and 15 stand rejected "for the same reason as the rejection to claim 5." Office Action, 03/30/2004, paragraph 18. As established in the foregoing, the Examiner has not established a *prima facie* case that *Elliott* and *Asano*, taken alone or in combination, disclose every limitation of independent claims 1, 6 or 11. The foregoing arguments for

claim 5 also apply to 10 and 15, therefore, dependent claims 10 and 15 are also allowable over *Elliott* in view of *Asano*. In summary, dependent claims 5, 10 and 15 are allowable over the references because the references do not disclose every element of independent claims 1, 6, and 11 and dependent claims 5, 10 and 15.

In summary, the Examiner has not established a *prima facie* case that every limitation of claims 1-15 is disclosed in *Elliott* and *Asano*, taken alone or in combination. Rather than make a clear and particular showing, the Examiner makes broad and conclusory statements, which are not evidence. For at least the foregoing reasons, Applicants respectfully assert that claims 1-15 are allowable over *Elliott* in view of *Asano*.

Ordinary Skill and Relevant Art

In resolving the level of ordinary skill of the pertinent art, as required by the third step in *Graham*, the Examiner must step backward in time and into the shoes worn by a person of ordinary skill when the invention was unknown and just before it was made. The hypothetical person skilled in the art can summarily be described as one who thinks along lines of conventional wisdom in the art and neither one who undertakes to innovate nor one who has the benefit of hindsight. Thus, neither an examiner, nor a judge, nor a genius in the art at hand, nor even the inventor is such a person skilled in the art.

In order to establish a *prima facie* case of obviousness, it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge that one having ordinary skill in the art would have been led to modify or combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300, 1301 (Bd. Pat. App. & Int. 1993); *Ashland Oil, Inc. v. Delta Resins and Refractories, Inc.*, 776 F.2d 281 (Fed. Cir. 1985). The motivation or suggestion to modify or combine references must come from one of three possible sources: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 47 U.S.P.Q. 2d 1453, 1458 (Fed. Cir. 1998). The showings must be clear and particular. *In re Dembiczk*, 50 U.S.P.Q.2d 1614, 1617 (Fed.

Cir. 1999). Broad conclusory statements regarding the teachings of multiple references, standing alone, are not evidence. *Id.*

There is no motivation to combine *Elliott* and *Asano*. The Examiner states as motivation, "they both dealing with retrieving with retrieving [sic] parameters and functioning as a gateway between two nodes in a network." Office Action, 03/30/2004, paragraph 11. Furthermore, the Examiner states as motivation, "the teaching of *Asano* to allow accessing an application server on behalf of said client application in accordance with said retrieved parameter for said first end-user would improve the latency and communication costs for *Elliott's* system by allocating the processing power which needed to retrieve the data from the client side to the gateway side, thus improving efficiency." *Id.* These are the Examiner's subjective opinions, unsupported by any facts or objective evidence.

The legal conclusion of obviousness must have a correct factual basis. *See Graham v. John Deere & Co.*, 383 U.S. 1 (1966); *In re Rouffet*, 47 USPQ2d 1453, 1455 (Fed. Cir. 1998). Where the legal conclusion is not supported by facts, it cannot stand. *Id.* A rejection based on § 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). The patentability of an invention is not to be viewed with hindsight or "viewed after the event." *Goodyear Company v. Ray O Vac Company*, 321 U.S. 275, 279 (1944). The proper inquiry is whether modifying or bringing them together was obvious and not, whether one of ordinary skill, having the invention before him, would find it obvious through hindsight to construct the invention. Accordingly, an Examiner cannot establish obviousness by locating references which describe various aspects of the patent Applicant's invention without also providing evidence of the motivating force which would compel one skilled in the art to do what the patent applicant has done.

The Examiner's rejection of claims 1-15 does not rest on a factual basis. Instead, the Examiner has attempted hindsight reconstruction of the invention by picking elements from *Elliott* and *Asano*. In many instances, only one word appears in common between the claim language and the cited section from *Elliott*. For example, for "directory comprising data for

each end-user" from claim 1, the Examiner cites Col. 202, lines 56-63 which mentions a "Directory Server." For "retrieving parameters associated with said data" from claim 1, Examiner cites to Col 116, lines 64-67 which uses the word "retrieves." For "disabling entries" and "enabling entries" from claim 3, the Examiner cites to Col. 38, lines 4-7 which uses both words "enabling" and "disabling." For "informing" "that a server application is unavailable" from claim 5, Examiner cites to Col. 120, lines 56-61 which contains the text "unavailable." Despite the words between the claims and *Elliott* matching in some instances, the contexts in which the words are used is <u>not</u> <u>similar</u> at all. The Examiner repeatedly ignores the need for antecedent basis among claim elements when skipping around in *Elliott* to find claim elements. The obviousness rejections of claims 1-15 based on *Elliott* in view of *Asano* cannot stand because the rejections are not based on fact.
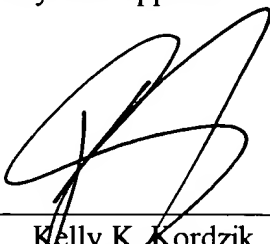
CONCLUSION

In consideration of the foregoing, Applicants assert that all remaining claims are in condition for allowance. Applicants respectfully request an early allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below-listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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